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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BINDA, GREGORY JOHN

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/738,458

Applicant(s)

ROHS ET AL.

Examiner

Greg Binda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 25-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/349,264.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/21/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

1. Applicant's election with traverse of Group I, a torsional vibration damper in the reply filed on Jan 21, 2005 is acknowledged. The traversal is on the ground(s) that the non-elected invention which is a method, is indistinct from the elected invention and because the parent to the instant application included claims to a method. This is not found persuasive because the elected and unelected inventions are distinct as noted in the prior Office action and because there is nothing in the prosecution of the parent application which necessarily precludes restriction in the instant application.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 25-35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on Jan 21, 2005.

Drawings

3. The drawings are objected to because:

- a. Figs. 2c-2j each show three thrust pistons when only two are warranted. Applicant should either eliminate the phantom third thrust piston or draw it with a broken line.

(Note: the phantom presentation must be explained in the description)

- b. Fig. 3 shows no less than ten thrust pistons when only two are warranted. (Note: each phantom thrust piston must be drawn with its own unique broken line pattern to avoid confusion.)
 - c. Reference numeral 34 appears in paragraphs 0042 & 0047, but does not appear in the drawings.
 - d. The drawings fail to show “its bottom side 34 upon the guide surface 11 of the first subassembly” as described in paragraph 0042.
 - e. The “translation” mentioned at paragraphs 0043+ is not indicated in the views which show the movement of the thrust pistons .
 - f. The drawings fail to show “the attack angle” described at paragraph 0047
 - g. The drawings fail to show “the plane of projection” described at paragraph 0054
 - h. The certain clearance described at paragraph 0058 is not indicated in the drawings.
 - i. It is not clear what Fig. 9 is supposed to show. Fig. 8 allegedly shows the position of the coupling elements parts immediately before the thrust pistons engage (see page 18, line 15) and Fig. 10 shows the thrust pistons during impact (see page 19, line 10). If this is so, then what condition of the coupling element is Fig. 9 showing?
4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be

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removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because:

- a. The current status of the applications cited in paragraph 0001 is unidentified.
- b. The brief description of Figs. 6-10 at paragraph 0038 is inadequate. Each view is different and shows a particular feature or condition. A proper brief description would reflect this.
- c. Paragraph 0043 states "both subassemblies are moved toward one another". How is that possible when the subassemblies are designed to be rotated in the same direction as suggested at page 2, lines 1-4.
- d. It is not clear whether or not the events described in paragraphs 0044+ occur only when the subassemblies are moved toward one another as set forth in the preceding paragraph.

e. Paragraph 0044 states “a translation is realized . . . which is almost equal to zero”.

What is a translation? How does said translation acquire a specific quantitative value?

What units of measure are used to define the quantity of ‘translation’?

f. In paragraphs 0044 & 0045 “translation” is expressed as a particular number (e.g. 0 or 1), but in paragraph 0046 translation is expressed as a ratio (e.g. 1:1). Why is there a difference?

g. Paragraph 0047 states “the frictional behavior of this arrangement can be influenced through appropriate selection of the attack angle”. What arrangement is “this arrangement”? Why is there no previous mention in the description of “the attack angle”?

h. Paragraph 0049 alleges that the description therein is “clearly shown”. Where?

i. Paragraph 0054 mentions “the plane of projection”. It is not clear what this means.

j. Paragraph 0058 mentions “an extension 45” but does not identify the part that this extension is an extension of.

k. Paragraph 0058 includes the phrase ‘it is possible to avoid that the right hand thrust piston 30 leaves’. It is not clear what that means.

l. The second and successive sentences at paragraph 0059 do not make any sense. To the extent that they can be understood, they appear to just be a collection of random statements without any support.

Claim Objections

6. Claim 11 is objected to because the parenthetical phrase at the end of the claim should be deleted.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has not pointed out where the following limitations are supported, nor does there appear to be a written description of the limitation in the application as originally filed:

- a. Claims 1 & 20-23: "an essentially tangentially effective elastic element".
- b. Claim 1, line 7: "a first phase in which the first and second subassemblies rotate relative to one another". See also claim 7.
- c. Claim 1, line 11: "a second phase when the rotation of the first and second subassemblies exceeds the predetermined angle of rotation". See also claim 7.
- d. Claim 1, line 14: "a restoring force which increases with increase in the relative rotation"

- e. Claim 7: “in the second phase [the thrust piston] is radially tilted relative to the first position”
 - f. Claim 9: “a recess forming a lateral support surface’
 - g. Claim 9: “said spring element engaging the respective recess of each thrust piston”
 - h. Claim 12: “the two thrust pistons . . . have a receiving position . . in relation to one of the two subassemblies”. In the description a single thrust piston is described as having a receiving position (see paragraph 0056), but there is no description of a receiving position constituted by two thrust pistons.
 - i. Claim 12: “the two thrust pistons . . . have an engagement position in relation to one of the two subassemblies”. In the description a single thrust piston is described as having an engagement position (see paragraph 0057), but there is no description of an engagement position constituted by two thrust pistons.
 - j. Claims 14 & 16: all limitations therein
 - k. Claim 20: “a relative compression of the elastic element”
 - l. Claim 2): “a degree of change in length of the elastic element which varies with the size of the rotational angle”
 - m. Claim 21, lines 11-14: all limitations therein
9. Claims 1-19 & 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

- a. Claims 1 & 3 recite that a thrust piston moves slower or faster depending on the relative rotation angle between the two subassemblies. There is no description of the structure that provides such a capability.
- b. Claim 1 recites that the thrust piston provides a restoring force that increases with an increase in the relative rotation angle between the two subassemblies. There is no description of the structure that provides such a capability.
- c. Claim 8 recites that the thrust pistons are brought into engagement with one another at a particular angle. No such particular angle is disclosed.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 2, 6, 7, 20 & 22-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- d. Claims 2 & 23 recite the term "a translation". As noted in multiple objections above, the term is inadequately presented in the disclosure. Such inadequacy precludes one from understanding what limitations (if any) are imparted by the recitation of the term.
 - a. Claim 6 recites the limitation "said guide surface". There is insufficient antecedent basis for this limitation in the claim.
 - b. Claim 6 recites the limitation, "a restoring force". It is not clear how this restoring force relates to the restoring force recited in claim 1.

- c. Claim 7 recites the limitation "the first position" in line 5. There is insufficient antecedent basis for this limitation in the claim.
- d. Claim 20 recites the term "a various relative angle of rotation". It is not clear what this term means or how it translates into a definable limitation of the claimed invention.
- e. Claim 20 recites the limitation "the thrust piston" in line 5. There is insufficient antecedent basis for this limitation in the claim.
- f. Claim 22, line 8 recites the limitation "guide surfaces" but it does not identify the element(s) whose surfaces these "guide surfaces" are surfaces of.
- g. Claim 24 recites the limitation "the displacement phase" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Schallhorn et al, US 4,148,200.

- a. Claim 20. Figs. 1-3 show a torsional vibration damper comprising: a first subassembly 16; a second subassembly 12 which can rotate relative to the first subassembly; and one coupling element 22 for interconnecting the two subassemblies.

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Figs. 2-4 show the coupling element 22 comprises: an elastic element 40 and a thrust piston 34. The relative compression/change in length of the elastic element 40 depends on the rotational movement between the two subassemblies because the elastic element 40 does not compress/change in length until after a predetermined amount of movement (see col. 2, lines 35+).

b. Claim 21. In addition to that noted above, Figs. 2 & 3 show the thrust piston 34 is displaced relative to the first subassembly 16 while at the same time applying (via the coupling element 22) a restoring force on the first subassembly.

c. Claim 22. In addition to that noted above, Figs. 2 & 3 show that the thrust piston 34 tilts with respect to the first subassembly 16 and that the amount of tilting varies with the amount of relative rotation between the two subassemblies.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (703) 305-2869. The examiner can normally be reached on M-F 9:30 am to 7:00 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703) 308-2686. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Greg Binda
Primary Examiner
Art Unit 3679